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EXAMINER	
TRAN LIEN, THUY	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEAKI SAKAI,
JUN KOHORI,
and MASAHIRO KATADA

Appeal 2008-3130
Application 10/083,387
Technology Center 1700

Decided: September 4, 2008

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
PETER F. KRATZ, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1, 3-20, and 22. We have jurisdiction under 35 U.S.C. § 6.

Appellants claim a method for producing fried instant noodles comprising heating the noodles in an oil/fat composition comprising at least

60 wt.% of diglycerides (claims 1, 19). Appellants also claim fried instant noodles obtained by such a process (claim 20).

Representative independent claim 1 reads as follows:

1. A method for producing fried instant noodles, comprising heating noodles in an oil/fat composition comprising at least 60% wt.% of diglycerides, wherein upon reconstitution of said fried instant noodles with water, said noodles have a smooth structure.

The references set forth below are relied upon by the Examiner as evidence of obviousness:

Miyazaki	5,916,619	Jun. 29, 1999
Gotoh	6,004,611	Dec. 21, 1999
Greene	6,042,866	Mar. 28, 2000

Claims 1, 3-7[1], 11-14, 16-20, and 22 are rejected under 35 U.S.C. § 103(a) over Greene in view of Gotoh; and claims 8-10 and 15 are correspondingly rejected over these references and further in view of Miyazaki.

Appellants separately group and argue: claims 1, 5-20, and 22; claim 3; and claim 4. With respect to the grouping of claims 1, 5-20, and 22, we select independent claim 1 to represent this grouping. Therefore, our disposition of this appeal will focus on claims 1, 3 and 4.

For the reasons expressed in the Answer and below, we will sustain the rejections advanced in this appeal.

[1] By inadvertent oversight, the Answer erroneously refers to claims 4-7 rather than 3-7 as included in this rejection (Ans. 3). This error is harmless since Appellants understand that the rejection also applies to claim 3 and indeed have separately argued claim 3 (App. Br. 3, 8-9).

The Examiner's findings of fact are not in dispute. Greene discloses a method of preparing fried instant noodles using a non-specified conventional frying oil and therefore fails to disclose the diglyceride feature of claims 1, 3, and 4 (Greene, col. 4, ll. 49-67; Ans. 3-4). However, Gotoh discloses frying foods such as noodles with oil containing preferably at least 50 % by weight diglycerides which inhibits the increase of blood triglyceride, is little accumulated in the body and is excellent in storage stability and flavor (Gotoh, col. 2, ll. 37-49, col. 8, ll. 17-21, claims 1-2; Ans. 4).

Based on these findings, the Examiner concludes that it would have been obvious for one with ordinary skill in this art to practice Greene's method by using frying oil containing diglycerides in the amounts taught by Gotoh in order to obtain the advantages taught by Gotoh (Ans. 4), thereby yielding the method required by claims 1, 3, and 4 respectively. We agree with the Examiner that these applied references evince a prima facie case of obviousness within the meaning of 35 U.S.C. § 103(a).

Appellants' nonobviousness position is premised on their contention that the claimed method produces superior results as evidenced by the Declaration of record filed January 8, 2004 under 37 C.F.R. § 1.132 (App. Br. 6-9, Reply Br. 3-7). Specifically, noodles produced by the claimed method are said to be superior in elasticity and smoothness when compared to noodles made using an oil/fat composition containing less than 60 wt.% of diglycerides (App. Br. 7, Reply Br. 5).

Evidence of unexpected results can be used to rebut a prima facie case of obviousness. *Pfizer, Inc. v. Apotex, Inc.,* 480 F.3d 1348, 1369-70 (Fed. Cir. 2007); *In re Peterson*, 315 F.3d 1325, 1330-31 (Fed. Cir. 2003). However, for several reasons, Appellants' Declaration evidence fails to

successfully rebut the prima facie case of obviousness established by the Examiner.

First, the Declaration never characterizes the results produced by the claimed invention as unexpected. Instead, the Declaration simply states that "the noodles made from the claimed method are clearly superior in elasticity and smoothness when compared to noodles made by an optimized process according to Green et al. utilizing the oil according to Gotoh et al. (Declaration 6). Superiority alone is inadequate to establish nonobviousness; the superiority must be unexpected. *See Pfizer*, 840 F.3d at 1371. For all we know, parameter-variation in this art is typically expected to produce changes which include superior (as well as inferior) properties such as elasticity and smoothness.

Second, as correctly observed by the Examiner (Ans. 7), the Declaration statement of superior elasticity and smoothness appears to be based on subjective opinion rather than objective facts. For example, inventive sample (2) is given a smoothness grade of B (i.e., "Smooth surface noodle") whereas comparative sample (3) is given a grade of C (i.e., "Rather smooth surface noodle") (Declaration 5-6). This record provides no insight as to the criteria by which a surface noodle is considered to be "Smooth" versus "Rather smooth". Because we do not know whether this criteria is based on reproducible objective fact or non-reproducible subjective opinion, the Declaration statement concerning elasticity and smoothness must be regarded as inconclusive *vis-à-vis* unexpected results.

Third, the Declaration showing is not commensurate in scope with argued claims 1, 3, and 4. *See Peterson*, 315 F.3d at 1330-31 (showing of unexpected results sufficient to overcome a prima facie case of obviousness

must be commensurate in scope with the claimed range). This is because the Declaration provides inventive results for only two diglyceride concentrations, namely, 64.7 wt.% and 85.7 wt.% (Declaration 3). Therefore, the Declaration showing is much more narrow in scope than claim 1 ("at least 60 wt.% of diglycerides"), claim 3 ("at least 65 wt.% of diglycerides"), and claim 4 ("at least 70 wt.% of diglycerides").

Finally, even disregarding the above discussed deficiencies, Appellants' Declaration evidence would not compel a nonobviousness conclusion. Although secondary considerations must be taken into account, they do not necessarily control the obviousness conclusion. *Pfizer*, 480 F.3d at 1372. *See also In re May*, 574 F.2d 1082, 1092 (CCPA 1978) and *In re Nolan*, 553 F.2d 1261, 1267 (CCPA 1977). Here, the prima facie case of obviousness and the advantages associated therewith are so strong that they outweigh Appellants' alleged advantages of superior elasticity and smoothness.

For the above stated reasons, Appellants have failed to carry their burden of rebutting the Examiner's prima facie case obviousness. *See In re Rhinehart*, 531 F.2d 1048, 1052 (CCPA 1976). It follows that we sustain each of the § 103 rejections advanced on this appeal.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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